

## **REMARKS/ARGUMENTS**

Claims 1-22 are pending in the Application. However, claims 17-22 were withdrawn as a result of a previous restriction requirement and election, and are shown herewith having "withdrawn" status. In addition, claims 6-7, 10, and 13-16 are currently unexamined as being drawn to non-elected species. Therefore, claims 1-5, 8, 9, 11 and 12 are presented for Examiner Mercier's consideration. Claims 1-5 are currently amended. Support for the amendment to claim 1 may be found, for example, in the Application Specification at page 4, lines 23-27 and at page 11 lines 15-30.

Applicants thank the Examiner for including in the Office Action mailed March 15, 2007 signed copies of the Forms PTO-1449 sent with Applicants' Information Disclosure Statements received in the Office on December 22, 2003, June 25, 2004, September 14, 2004 and September 29, 2005.

Pursuant to 37 C.F.R. § 1.111, reconsideration of the present application in view of the following remarks is respectfully requested.

### **Claims rejections, 35 U.S.C. §112 (claims 1-5, 8, 9, 11 and 12)**

On page 2 of the Office Action mailed March 15, 2007, the Examiner rejected claims 1-5, 8, 9, 11 and 12 under 35 U.S.C. §112 as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter. Specifically, the Examiner stated that it was unclear on which surface the lip care formulation is disposed. The Examiner's interpretation stated in the Office Action – that the lip care formulation is disposed on the exterior surface – is correct. In order to ensure clarity, the claims have been amended to explicit that "the surface" does indeed refer to the antecedent claim term "exterior surface".

In addition, the Examiner stated that the term "closer" in claim 5 is indefinite such that one skilled in the art would not be reasonably apprised of the scope of the invention. Claim 5 recites the device having an open end and having an exterior surface having both a lip care formulation and a texturized surface disposed on the exterior surface. Claim 5

additionally requires that the lip care formulation be closer to the open end than is the texturized surface. The Applicant submits that the meaning of the term "closer" is reasonably clear in this context taking its ordinary meaning, i.e., it requires that the distance between the device's open end and the lip care formulation must be less than the distance between the device's open end and the texturized surface.

**Claims rejections, 35 U.S.C. §102 (claims 1-5)**

On page 2 of the Office Action mailed March 15, 2007, the Examiner rejected claims 1-5 under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Pat. No. 2,131,077 to Snyder (hereinafter, "Snyder"). This rejection is respectfully **traversed** to the extent it may be applicable to claim 1 and its dependent claims 2-5.

The invention relates to single-use devices for providing and applying a lip care formulation, such as a device having a hollow member having an open end for insertion of a finger, that includes an exterior surface and a lip care formulation disposed on at least a portion of the exterior surface. More specifically, the invention as claimed in currently amended claim 1 is directed to the device including a hollow member having an open end for insertion of a finger, the hollow member including an exterior surface and a lip care formulation disposed on at least a portion of the exterior surface, and the device further including at least one elastic component.

In the Office Action it was asserted that:

Snyder discloses "a device which may be placed on the tip of the finger for spreading a substance on a surface, such as lipstick on the lips and does not merely force the substance over the surface, and in which the surface of the device is such that it takes up and retains surplus material, reserving it for future use" (column 1, lines 1-10). Additionally, the device has a "surface of such a texture that it may be impregnated with lipstick material" (column 1, lines 12-15).

No further discussion relating to the 35 U.S.C. §102(b) rejection of claims 1-5 was provided in the Office Action. The Applicant points out that although the text above following the words "Snyder discloses" is placed between quotation marks in the Office Action, as if it were a direct quote from the Snyder reference, this is not correct. Snyder does not disclose that his device "...may be placed on the tip of the finger...". Rather, Snyder states that his device "...may be used in place of the tip of a finger, handkerchief, or other article for spreading a substance on a surface, such as a lipstick..." (Snyder at column 1, lines 2-4; underline emphasis is added).

In addition, as currently claimed, the Applicant's claimed device requires inclusion of at least one elastic component. As discussed in Applicant's specification, inclusion of such an elastic component can provide form-fitting properties and help the device snugly fit onto a person's finger and so remain more effectively on the finger. After reviewing Snyder, it does not appear that Snyder discloses or even suggests use of an elastic component; even if Snyder contemplated use of his device on a finger (which as Applicant points out above, is not what Snyder discloses), Snyder does not appear to teach or even contemplate the device fitting over a user's finger in a snug and form-fitting fashion. On the contrary, Snyder discloses that his device should be made from a rigid material, such as metal. Please see Snyder at page 2, first column, lines 1-3 and page 2, second column, lines 26-28.

For at least these reasons set forth above, the Applicant submits that Snyder fails to disclose the current invention as claimed in independent claim 1, and dependent claims 2-5 included in the 35 U.S.C. §102(b) rejection. Therefore, the Applicant respectfully requests that the rejection of claims 1-5 under 35 U.S.C. §102(b) over Snyder be withdrawn.

#### **Claims rejections, 35 U.S.C. §103 (claims 8, 9, 11, 12)**

On pages 3 and 4 of the Office Action mailed March 15, 2007, the Examiner rejected claims 8, 9, 11 and 12 under 35 U.S.C. §103(a) as allegedly being obvious over above-mentioned Snyder in view of U.S. Pat. No. 4,820,508 to Wortzman (hereinafter,

"Wortzman"). This rejection is respectfully **traversed** to the extent it may be applicable to claims 8, 9, 11 and 12.

Independent claim 1, from which claims 8, 9, 11 and 12 depend, and the Snyder reference are described above with respect to the rejection of claims 1-5 under 35 U.S.C. §102(b). As noted by the Examiner, Wortzman discloses skin protective composition suitable as a lip balm, and the skin protective composition may include ingredients such as oxybenzone, padimate O and dimethicone.

However, as described above, the primary reference (Snyder) fails to disclose all of the elements of the Applicant's claim 1 from which claims 8, 9, 11 and 12 ultimately depend. After a review of the Wortzman reference, it does not appear that Wortzman remedies the deficiencies of the primary reference. (To be clear, the Examiner did not assert that Wortzman provided teachings other than the protective lip balm and the particular ingredients.)

Therefore, for the reasons stated above, the Applicant respectfully submits that neither reference alone nor the references in combination teach or suggest the Applicant's invention as claimed. Therefore, the Applicant respectfully submits that the rejection of claims 8, 9, 11, and 12 under 35 U.S.C. §103(a) over Snyder in view of Wortzman should be withdrawn.

The Applicant also respectfully submits that for at least the reasons indicated above relating to corresponding independent claim, the pending dependent claims patentably define over the references cited. However, the Applicant also notes that the patentability of the dependent claims certainly does not hinge on the patentability of independent claim. In particular, it is believed that some or all of these claims may possess features that are independently patentable, regardless of the patentability of the independent claim.

For at least the reasons stated above, it is respectfully submitted that all of the currently presented claims are in form for allowance.

Please charge any prosecutorial fees which are due to Kimberly-Clark Worldwide, Inc. deposit account number 11-0875.

The undersigned may be reached at 770-587-8908. Should any issues remain after consideration of the remarks and explanations made herein, Examiner Mercier is invited and encouraged to telephone the undersigned at her convenience.

Respectfully submitted,

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CERTIFICATE OF TRANSMISSION

I, Robert A. Ambrose, hereby certify that on July 16, 2007, this document is being transmitted to the United States Patent and Trademark Office via the EFS-Web System.

By: /Robert A. Ambrose/

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